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In re Application of
Takashi Sato et al.
Application No. 10/587,902
Filed: July 29, 2006
Attorney Docket No.: **2006_1189A**

OFFICE OF PETITIONS

ON PETITION

This is a decision on the petition filed August 19, 2009 to withdraw the holding of abandonment, which is being treated under 37 CFR 1.181 in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.¹

The petition under 37 CFR 1.181(b) is **GRANTED**.

This application became abandoned on December 2, 2008, for failure to file a timely response to the Restriction Requirement mailed October 29, 2008, which set a one (1) month statutory period for reply. Accordingly, a Notice of Abandonment was mailed August 4, 2009. Petitioner asserts that the office action was never received.

The file record discloses that the Office Action was mailed to the address of record at the time, which is the same address used on all correspondences from the USPTO prior to the mailing of the Office Action. In support of the allegation that the Office

¹MPEP 711.03(c) states, in pertinent part:

In *Delgar v. Schuyler*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

Action mailed on October 29, 2008 was never received, petitioners have submitted a copy of their docket record and states that a search of the docket and the file jacket indicates that the Office Action was not received. A copy of the docket record and file jacket have been referenced in the petition and are included herewith.

A review of the record indicates no irregularity in the mailing of the Office Action mailed on October 29, 2008, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office Action mailed on June 30, 2008, was properly mailed to the address of record. This presumption may be overcome by a showing that the Office Action mailed on June 30, 2008 was not in fact received.

The docket record filed with the petition appears to be a master docket record, and is being so construed. Petitioners must inform the Office if this is an incorrect interpretation.

Accordingly, there was no abandonment in fact. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. No fees are due and none have been charged.

The Notice of Abandonment is withdrawn and this matter is being referred to Technology Center 1749 for a re-mailing of the Restriction Requirement originally mailed October 29, 2008 and for a restarting of the period for reply.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.



Patricia Faison-Ball
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Office of Petitions